

Remarks

Claims 1-19 are pending in the present application. Claims 1, 2, 7, 8, 13, 14 and 19 stand rejected for anticipation by U.S. Patent No. 5,220,674 to Morgan. Claims 3, 4, 9, 10, 15 and 16 stand rejected for obviousness over Morgan in view of U.S. Patent No. 5,754,767 to Ruiz. Claims 5, 6, 11, 12, 17 and 18 stand rejected for obviousness over Morgan in view of U.S. Patent No. 5,935,262 to Barrett et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

On page 2 of the Office Action, it is stated that print server 10 of Morgan allegedly discloses extracting job attribute information from a print job wherein the job attribute information includes information identifying system resources to be used in executing the print job with reference to teachings in column 7, lines 20-29 of Morgan. A careful read of the teachings in column 7, lines 20-29 of Morgan, state that if a printer 16 does not have a specific resource locally available, print server 10 provides a resource from an internal collection or attempts to have the resource supplied from another component. Such teachings in no fair interpretation disclose or suggest *extracting job attribute information from a resource job wherein the job attribute information includes information identifying system resources to be used in executing the resource job*. To the contrary, Morgan merely accommodates a lack of resources by supplying such resources internally or from another component. Morgan fails to disclose or suggest the claimed job processor for extracting job attribute information specified in claim 1 and claim 1 is allowable for at least this reason.

On pages 2 and 3 of the Office Action, it is stated that a resource agent for receiving job attribute information from a job processor and job result information returned from the printer wherein the job result information identifies the results achieved by the printer in response to the print job is allegedly disclosed in column 10, lines 14-16 of Morgan. A careful read of column 10 reveals that such identified teachings of Morgan merely disclose a status collector which serves an event logger including receiving reports of events and activities and forwarding of reports of status changes. The identified teachings of Morgan regarding generic event logging activities fail to disclose or suggest

the claimed resource agent *for receiving job attribute information from the job processor and job result information returned from a resource wherein the job result information identifies the results achieved by the resource in response to the resource job* as defined in claim 1. There is absolutely no identification of the specific events logged in Morgan and in no fair interpretation do the disclosed generic teachings teach or suggest the claimed receiving by the resource agent. These additional positively recited limitations of claim 1 are not shown nor suggested in the prior art, and claim 1 is allowable for at least this additional reason.

On page 3 of the Action, it is stated that the resource collecting server includes a resource collector for receiving the job attribute information and job result information and generates corresponding job detail information representing system resources used in executing the print job. The only teachings of Morgan identified in support of the position of the Examiner are reference number 10 of Fig. 1. Applicants have failed to uncover any teachings or suggestion of the claimed *resource collector for receiving job attribute information and job result information and generating corresponding job detail information representing system resources used in executing the resource job* as defined in claim 1. No specific teachings of Morgan have been identified in support of the assertions that Morgan discloses the claimed resource collector for receiving and generating, and Applicants have failed to uncover any such receiving or generating by structure 10 or other structure of Morgan. The claimed resource collector is not shown or suggested in the prior art of record and claim 1 is allowable for at least this additional reason.

Applicants have identified numerous positively recited limitations which are not shown nor suggested by the prior art. Applicants respectfully request clarification in a subsequent non-final Action of the specific teachings of Morgan relied upon as allegedly disclosing limitations of claim 1 so Applicants' may appropriately respond if claim 1 is not found to be allowable in the next Action. In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows

or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) if any claims are not found to be allowable in the next Action.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claims 3 and 4 stand rejected for obviousness over Morgan in view of Ruiz. Applicants disagree with the obviousness rejection. As set forth in the abstract of Ruiz, it is clear that such teachings relate to a method for determining physical locations of devices located on a series connected network. As set forth in the title and abstract of Morgan, such relates to a local area print server. Claims 3 and 4 define a system resource usage monitoring system. It is clear that Ruiz is non-analogous subject matter to the present invention. In particular, the combination of non-analogous art areas is precluded by long standing Federal Circuit precedent. Prior art references are only analogous if the reference is in the field of Applicants' endeavor or the reference is reasonably pertinent to the particular problem with which the inventor was concerned. MPEP §2141.01(a) (citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Ruiz is not within Applicants' endeavor nor reasonably pertinent to a particular problem with which the inventors were concerned. The obviousness rejection over Ruiz is inappropriate for at least this reason.

It is stated on page 4 of the Action that the combination of Morgan and Ruiz would be employed such that the dynamic discovery function for identifying a current location of a current resource collecting server on a network would save time when job information needs to be retrieved. Such assertion fails to establish proper motivation required for an obviousness rejection to combine reference teachings.

Referring to MPEP §2143.01 (8th ed.), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by a combination of references unless there is some motivation in the art to support the combination. See *ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

There is absolutely no evidence or details of record that operations of Morgan are inefficient with respect to time and there is no evidence that one of skill in the art would be motivated to modify Morgan to improve efficiencies with respect to time. Further, there is absolutely no evidence or details of record that a combination of the teachings of Ruiz with Morgan would save time when job information needs to be retrieved. There is no evidence that teachings of Ruiz could in fact be combined with the teachings of Morgan or that if such combination was achieved, that any time would be saved. Apart from bald, cursory statements, the Office Action fails to identify clear and particular motivation to combine the teachings of Ruiz with the teachings of Morgan. One of skill in the art would not be motivated to modify the teachings of Morgan with the teachings of Ruiz and the rejection of claims 3-4 is improper for at least this reason.

In addition, the abstract of Ruiz illustrates the patent is concerned with a method for determining the physical locations of devices located on a *series* connected network. Referring to Fig. 1 of Morgan, references 12, 14 identified in the Office Action as allegedly corresponding to the claimed communications network are arranged in a parallel arrangement. Such is additional evidence that one would not be motivated to combine the inapposite teachings of Ruiz

concerned with serial network arrangements with the system of Morgan. There is no motivation to combine the teachings of Ruiz with the teachings of Morgan and the obviousness rejection of claims 3 and 4 is improper for at least this additional reason.

Referring to the rejections of claims 5 and 6 over the combination of Morgan and Barrett, Applicants submit motivation in support of the combination is lacking. As set forth on page 5 of the Action, the combination is allegedly appropriate to employ a local printer accessible to a client system and to forward print instructions, document data and job result information to a print server in order to maximize the print server status control and capability over the entire network. The teachings in column 7, lines 20-29 make clear that Morgan is concerned with management of printers 16 of printing system 17. As set forth in column 6, lines 17-20, it is clear that Morgan is concerned with requests from clients for services of printing system 17 managed by print server 10. There is absolutely no motivation for one of ordinary skill in the art to combine teachings of Barrett concerning a local printer with the printing system 17 or management of already present printers 16 of system 17 by print server 10. There is no evidence of record that print server 10 arranged to manage and monitor printers 16 of printing system 17 could be modified to accept communications from a local printer (i.e., outside of printing system 17), or that one would be motivated to do so apart from the bald, cursory statements in the Office Action. Morgan already provides control over the existing printers 16 of system 17 and there is no motivation to add another localized printer. There is no motivation in support of the rejection of claims 5 and 6 and the obviousness rejection is improper for at least this reason.

Referring to claim 7, the prior art of record fails to disclose or suggest a job processor for extracting job attribute information from the print job wherein the job attribute information includes information identifying system resources to be used in executing a print job, a resource agent for receiving job attribute information from the job processor and job result information returned from the printer wherein the job result information identifies the results achieved by the printer in response to the print job, or a resource collector for receiving the job attribute information and the job result information and generating corresponding

job detail information representing system resources used in executing the print job as defined. Claim 7 recites numerous limitations not shown nor suggested by the prior art and claim 7 is allowable for at least this reason.

Applicants respectfully request identification of specific prior art teachings which allegedly correspond to limitations of claim 7 in a non-Final Action in accordance with the CFR if claim 7 is not found to be allowable.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 13, the prior art of record fails to disclose or suggest extracting job attribute information from the resource job wherein the job attribute information includes information identifying system resources to be used in executing the resource job, returning job result information from the resource receiving the resource job to the resource server wherein the job result information identifies the results achieved by the resource in response to the resource job, forwarding the job attribute information and job result information returned from the resource to a collecting server, or generating corresponding job detail information representing system resources used in executing the resource job as defined. Claim 13 recites numerous limitations not shown nor suggested by the prior art and claim 13 is allowable for at least this reason.

Applicants respectfully request identification of specific prior art teachings which allegedly correspond to limitations of claim 13 in a non-Final Action in accordance with the CFR if claim 13 is not found to be allowable.

The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

*Serial No. 09/384,839
Case No. 10990926-1
Amendment A*

Respectfully submitted,
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INVENTOR(S): Craig R. White and Binnur Al-Kazily

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FILED: August 27, 1998

EXAMINER: A. Boutah

SUBJECT: Automatic Job Resource Usage and Retrieval

VERSION WITH MARKINGS TO SHOW CHANGES MADE ACCOMPANYING
RESPONSE TO APRIL 19, 2002 OFFICE ACTION

In the Specification

The replacement specification paragraphs incorporate the following amendments. Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

The paragraph beginning at line 19 on page 4 has been amended as follows:

Fig. 1 is a ~~block diagram of a networked system incorporating map~~ showing how Figs. 1A-1B are to be assembled. After assembly, Figs. 1A-1B provide a block diagram of a networked system incorporating the present invention.

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